



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/032,692 | 12/27/2001 | Peter Collinge | HR1.P04 | 7282 |

7590

10/01/2002

Michelle Bos
Stratton Ballew PLLC
213 South 12th avenue
Yakima, WA 98902

EXAMINER

MCCORMICK, SUSAN B

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 10/01/2002

2

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,692

Applicant(s)

COLLINGS, PETER

Examiner

Susan B. McCormick

Art Unit

1661

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1661

Detailed Action

Drawings

The drawings have been approved by an official draftsman.

Title

The following title is suggested: "Apple tree named 'CJ07'."

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

Art Unit: 1661

The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

- A. The disclosure is objected to under 37 CFR 1.121(e) because the Latin name of the genus and species of the plant claimed should be preceded by the heading set forth in 37 CFR 1.163(c) (4).
- B. Applicant should refer to cultivar names within single quotation marks, as this is the convention employed by the International Code of Botanical Nomenclature.
- C. Applicant should be more descriptive with the comparison between the parents 'X' and 'Z' and the observed plant, 'Y' in how they differ from each other and other known cultivars.
- D. On page 1, line 10, Applicant should denote a name for the observed plant as the recitation "temporary denomination" is insufficient. Correction is needed.
- E. On page 1, line 10, Applicant states that the discovery was on a "whole tree mutation" but on line 11, Applicant states "The sport arose on a tree...". Clarification is needed.
- F. On page 1, line 17, it is unclear as to what Applicant is meaning with the term "block" in the recitation "dark red block colour." Clarification is needed.
- G. Additional information should be imported into the specification relative to the observed height and spread for the observed tree at a specified age and location of culture and/or amount of growth over a specified period of time. The recitations "Medium size" and "medium vigour" does not adequately describe the size or vigor of the observed tree. Clarification is needed.
- H. Applicant should disclose information regarding the size (length and width), average number (per square inch) and color of the lenticels of the branch.

I. Applicant should disclose the shape, shape of the apex and base and color (both surfaces) of the observed leaf as well as the leaf's vein color and venation pattern.

J. Applicant should disclose the petiole diameter and color.

K. Applicant should disclose the size, amount and color of the stipules as "small to insignificant stipule size" is insufficient and vague.

L. Applicant should disclose the length and diameter of the flower bud.

M. On page 4, lines 4-5, Applicant states that the flower bud color is "RHSCC 55b fading to white as the flower opens." In FIG. 4 of the drawings, it shows an opened flower with an obvious pink color shown. Clarification is needed.

N. Applicant should set forth the flower diameter, observed number of flowers per cluster and characteristic fragrance (if any).

O. Applicant should set forth in the specification the shape, shape of the base and apex, margin, color (both surfaces), and texture of the petal.

P. Applicant should set forth in the specification the size (length and width) and color of the sepals. The terms "small" is vague and insufficient in this regard. Correction is needed.

Q. Applicant should set forth in the specification the reproductive organs. Applicant should disclose information such as the sizes (lengths), number and colors and describe these structures in the interest of providing as complete a botanical description of the observed plant as is reasonably possible.

R. Information relative to pollination requirements of the instant tree should be included in the specification, if available.

S. On page 4, line 15, the recitation "Medium thickness" does not describe the diameter of the stem. Applicant should disclose a quantitative measurement for the diameter. Correction is needed.

Art Unit: 1661

T. On page 4, line 17, the recitation "Size, medium" does not describe the eye adequately. Correction is needed.

U. On page 5, line 2, the term "Medium" does not describe the texture of the flesh of the observed fruit. Applicant should utilize a more appropriate term such as --fine-grained--, --smooth-- or --crisp--. Correction is needed.

V. Applicant should disclose known shipping and storage characteristics of the observed variety, for example, the number of days the fruit has been stored under specific conditions.

W. If additional information is available relative to plant/fruit disease resistance/susceptibility, such should be set forth in the specification.

X. Applicant should disclose information to the observed plant's winter hardiness and drought/heat tolerance.

Y. The claim in this case is improper. The claim must be to the instant plant as illustrated and described. An acceptable claim would be, "A new and distinct **tree** as herein described and illustrated." (emphasis added). Should Applicant desire, the present descriptive language could also remain in the claim.

The above listing may not be complete. Applicant should carefully review the disclosure and import any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. § 112, 1st and 2nd Paragraphs

Art Unit: 1661

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.


Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick whose telephone number is (703) 305-1682. The Examiner can normally be reached Monday through Thursday from 7:00 a.m. to 4:30 p.m. and alternate Fridays from 7:00 a.m. to 3:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

sbm


BRUCE R. CAMPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600